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10/549,375	01/26/2007	Andrew Michael Wild	148392.00000	3476

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EXAMINER
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DORNBUSCH, DIANNE

ART UNIT	PAPER NUMBER
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3773

MAIL DATE	DELIVERY MODE
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11/05/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/549,375

Applicant(s)

WILD, ANDREW MICHAEL

Examiner

DIANNE DORNBUSCH

Art Unit

3773

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
2. Claims 7-10 and 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claim 7 recites the limitation "the respective planes" in the 2<sup>nd</sup> line. There is insufficient antecedent basis for this limitation in the claim.
4. Claims 8 and 9 recite the limitation "the plane" and "the plane or planes". There is insufficient antecedent basis for this limitation in the claim.
5. Claim 10 recites the limitation "the plane or planes" in the 2<sup>nd</sup> line. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 12 recites the limitation "the cooperating parts of the reaction surface" in the 2<sup>nd</sup> line. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 3-19, and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Morrish et al. (4,878,276).

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Morrish discloses the following claimed limitations:

Claim 1: A clip comprising: a base portion (25); a pair of resilient limbs (10) each extending from the base portion (Fig. 1 and 4) and each having a free (14, 12) end disposed forward of the base portion (Fig. 1 and 4), wherein the limbs each extend in generally opposite lateral directions from a point of connection to the base portion of the clip (Fig. 4) and each is configured along its length so that the free end of the limb is disposed forward of the base portion of the clip (Fig. 4); and a reaction portion (38) mounted to and extending from the base portion (Fig. 3a) via a neck portion (39), the reaction portion defining a generally forwardly directed reaction surface disposed between the base portion and the free end of the limbs (Fig. 4), wherein the limbs are movable under a resilient restoring force from a first, open, condition (Fig. 4b), in which a gap is provided between the limbs (Fig. 4b) and the reaction portion for receiving the body passageway (40) into the clip (Fig. 4b), to a second, closed, condition (Fig. 4a), in which the limbs cooperate with the reaction portion to grip the body passageway to occlude the same body passageway (Fig. 1 and 4a).

Claim 3: The base portion and reaction portions are disposed generally centrally between the pair of limbs (Fig. 4).

Claim 4: The reaction surface is substantially fixed in relation to the movement of the limbs (Fig. 4a-b where it is seen that the resilient member does not change once the limbs are open or closed).

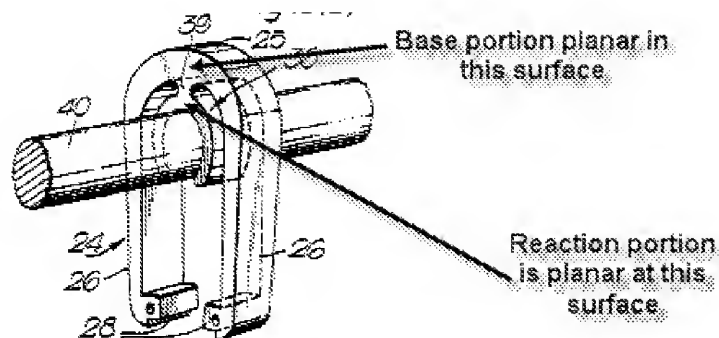
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Claim 5: The reaction surface is elongate (the reaction surface is made up of a base (33) with two legs (36), the legs are elongate since they have a larger length than width as seen in Fig. 3a).

Claim 6: The reaction surface and the limbs are suitably dimensioned and arranged so that in the closed condition of the clip substantially the entire transverse width of the occluded body passageway (40) is in contact with the reaction surface (Fig. 1 and 3b).

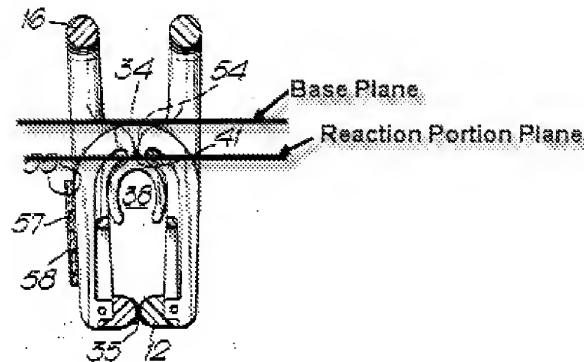
Claim 7: At least two parts of the clip (27 and the outer most part of 28 which is facing the other leg 26) are generally planar (Fig. 3 and Col. 4 Lines 49-51) and the respective planes are offset against one another (Fig. 3).

Claim 8: At least the base portion and the reaction portion of the clip are generally planar (see figure below where the two parts are planar at the outer surface) and the plane of the base portion (one of the planes of the base portion is located on the planar surface indicated in the figure below) is at a small angle to the plane of the reaction portion (one of the planes of the reaction portion is located on the planar surface indicated in the figure below). The planes indicated above for both the reaction and base portion are at the same location therefore the angle is approximately 0 degrees which is a small angle.



Claim 9: The base portion, the reaction portion and each limb are generally planar (see figure above for the planar part of the base and reaction portion (rejection of claim 8) and the portion 29 of the limbs is planar (Fig. 1 and Col. 4 Lines 49-50) and the plane of each limb (one of the planes is parallel to the flat surface 29 of the limb) is at a small angle to the plane or planes of the base portion and plane of the reaction portion (see the rejection of claim 8 for the description of one of the planes of the base and reaction portion). The plane of the limb described above is between 45-90 degrees (Fig. 1 and 4) which is a small angle.

Claim 10: One limb (10) lies slightly to one side of the plane or planes of the base portion and the reaction portions (see figure below where one plane of the base portion and the reaction portions is seen), and the other limb (10) lies slightly to the opposite side of those planes (see figure below), whereby the free ends of the limbs overlies opposite sides of the reaction portion in the closed condition of the clip (see figure below and Fig. 1).



Claim 11: The reaction surface is shaped in a manner generally complementary to the shape of those parts of each limb which cooperate with the reaction surface in the closed condition of the clip (Fig. 1).

Claim 12: At least one of the opposed cooperating parts of the reaction surface and each limb is provided with surface projections (on the reaction surface part 37 act as surface projections and on the limbs part 12 and 54 have surface projections as seen in Fig. 2a) which serve in use to enhance grip of the clip on the body passageway (Fig. 1).

Regarding the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

Claim 13: The surface projections are selected from the group consisting of rounded teeth, pointed teeth, nipping heads, or any combination thereof (Fig. 2a and 3a).

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Claim 14: Each limb is connected to the base portion of the clip via a curved portion (34) of the limb (Fig. 2a) defining a connection point to the base portion behind the reaction portion of the clip (Fig. 1 and 4a).

Claim 15: A further curve (32) is provided in the limb in the opposite direction to the said curved portion (Fig. 2a), whereby the free end of the limb is disposed forward of the base portion of the clip (Fig. 1 and 4).

Claim 16: An elongate portion (44) is provided in each limb between the curves (Fig. 2a), whereby during closure a leverage effect is produced on the part of the limb which is in contact with the body passageway (Fig. 4).

Claim 17: The base portion of the clip is in the form of an open loop or generally U-shaped member (Fig. 3a) having a closed end directed away from the limbs (the outer most parts at the top part which is best seen in Fig. 1) and an open end (26 and the sides which are not seen in Fig. 1) at which the limbs and the reaction portion are connected to the base portion (Fig. 4).

Claim 18: The reaction portion of the clip is provided in two halves (Fig. 3), each half is connected to one side of the open end of the base portion via a neck region (39) (Fig. 4) and which are complementarily juxtaposed to define the reaction surface of the clip (Fig. 4).

Claim 19: The base portion of the clip is provided with a weak region or point (the point where it is connected to the neck which is a weak portion due to the reduced diameter which can cause the part to break at that point) at which the base portion may be cut to remove the clip from the body passageway.



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Regarding the last statement, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim 22: An elongate portion (44) is provided in each limb (the two limbs (10) are the same structure therefore the two have the part 44) between the curves (Fig. 2a), whereby during closure a leverage effect is produced on the part of the limb which is in contact with the body passageway (Fig. 1 and 4).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morrish et al. (4,878,276).

Morrish discloses the claimed invention including that the device can be integrally formed of a plastic (Col. 1 Lines 63-68) where there is a resilient component that is shape memory and elastic since it returns to its original position (24), however Morrish does not disclose that the material is a superelastic plastic nor that it can be made of nitinol metal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the clip out of a superelastic material or out of nitinol metal, since it has been held to be within the general skill of a worker in the art to

select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1-4 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DIANNE DORNBUSCH** whose telephone number is (571)270-3515. The examiner can normally be reached on Monday through Thursday 7:30 am to 5:00 pm Eastern.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. D./  
Examiner, Art Unit 3773

/Julian W. Woo/  
Primary Examiner, Art Unit 3773